1. This Case Does Not Involve "Aesthetic" Functionality

DFG devotes the bulk of its petition to arguing that the circuits have adopted different approaches to the question of "aesthetic functionality." DFG defines aesthetic functionality as "a legal theory under which a product feature that has no operational or utilitarian function can nonetheless be deemed functional if it is 'aesthetically pleasing.'" Pet. 18 (emphasis added). If the Federal Circuit had held that some feature of DFG's stand and box that had no "operational or utilitarian function" was nonetheless functional solely because it was aesthetically pleasing, DFG's discussion might be of some relevance to this case. But the Federal Circuit made no such holding.

In the course of its discussion of secondary meaning, the court of appeals observed:

> We find that the copied elements of DFG's tree stand that were identified as being non-functional by the district court (i.e., the colors, the plastic rim, and the display box) were, in fact, utilitarian in nature.

Pet. App. 11a (emphasis added). That observation is plainly correct.[7] As noted above, the plastic rim had the utilitarian function of protecting the user from cutting his/her hands on the jagged edges or burrs it covered.[8] The display box was admittedly chosen for the functional purposes of making the product visible to and touchable by potential buyers, AP04295-303, and the colors red and green have an obvious "operational or utilitarian function" in marketing a Christmas product. *See Aromatique*, 28 F.3d at 874. Indeed, DFG

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[7] At oral argument in the Federal Circuit, DFG's counsel was asked twice to identify any affirmative evidence of non-functionality and each time was unable to identify any such evidence. *See* n. 4, *supra*.

[8] *See* n. 1, *supra*.

admitted to the jury it was not claiming the particular shade of green it used.[9] Nothing in the Federal Circuit's decision turns on a conclusion that any feature of DFG's product design or packaging was functional solely because it was "aesthetically pleasing."

DFG attempts to avoid this difficulty by arguing that what is protectable as its "trade dress" is not any single element of its design and packaging, but an overall "composite." As the Ninth Circuit has declared, however:

> Where the plaintiff only offers evidence that the 'whole is nothing more than the assemblage of functional parts,' . . . 'it is semantic trickery to say there is still some sort of separate "overall appearance" which is non-functional.'[10]

Here, as the Federal Circuit concluded, each of the elements on which DFG relies had evident functional value of an "operational or utilitarian" sort. The court held only that even if a competitor "copied" such functional elements, that fact could not support an inference that DFG's design and packaging had acquired secondary, source-identifying meaning in the minds of consumers. Nothing in that holding raises any question about "aesthetic" functionality.

2. There is No Prohibition Against the Copying of Functional Design Elements

DFG argues that the circuits "are divided as to the relevance and weight to be given evidence of intentional copying of a competitor's trade dress in the secondary meaning determination." Pet. at 25. As this Court has

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[9] *See* n. 3, *supra*.

[10] *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 786 (9th Cir. 2002), citing *Leatherman Tool Group, Inc. v. Cooper Indus., Inc.*, 199 F.3d 1009, 1013 (9th Cir. 1999).

stressed, however, "[i]n general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying"; and it is a "well-established rule that trade dress protection may not be claimed for product features that are functional." *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001). The Federal Circuit's decision (under Ninth Circuit law) simply applies that well-settled rule:

> . . . it is the copying of non-functional elements of a product's design that can yield an inference of secondary meaning.

Pet. App. 11a (emphasis added) Were the rule otherwise, a plaintiff could introduce evidence that a defendant "copied", for example, a standard paper-clip as evidence that consumers associate the conventional paper-clip shape with a particular manufacturer or product source.

Here, there was no substantial evidence that respondents copied any non-functional element of DFG's product or package design. Accordingly, DFG cannot show that any other circuit would have reached a different result on the facts of this case—or, indeed, *could* properly reach a different result, given the clarity with which this Court has recently spoken to the issue.

3. There is No "Circuit Split in the Making" on the Law of Actual Confusion as It Applies to the Secondary Meaning Analysis

Finally, DFG argues that the Federal Circuit erred in applying Ninth Circuit law concerning "retailer source confusion," thus creating a "circuit split in the making." Pet. 27, 29. Even if that were correct, the clarification of Ninth Circuit law would be a matter best left to that court itself. *Cf. Wisniewski v. United States*, 353 U.S. 901, 902 (1957) (per curiam). In fact, however, the Federal Circuit correctly stated:

> It is clear from Ninth Circuit precedent that the key question in determining actual confusion for the purposes of a secondary meaning inquiry is whether consumers or 'the relevant buying public' are actually confused.... We are aware of no precedent in the Ninth Circuit that would allow the confusion of 'the relevant buying public' to be inferred by testimony from company employees or associates. The evidence presented at trial by DFG only shows that a few Home Depot and DFG employees and associates may have been confused as to the origins of the tree stands at issue in this case. That evidence is not substantial evidence of actual consumer confusion.

Pet. App. at 12a-13a. That application of existing law to the facts of this case – in an unpublished opinion – does not amount to "the ... pronouncement of an absolute rule that retailer confusion is irrelevant to the determination of secondary meaning, contrary to Ninth Circuit precedent." Pet. at 29.

DFG cites a total of five instances of supposed confusion, involving a DFG employee, a DFG associate, and three Home Depot employees. Pet. at 10. The evidence involving the DFG employee and associate, even if credible, hardly supports an inference of source confusion on the part of consumers (or, for that matter, wholesale buyers). That DFG personnel associate DFG's stand with DFG and might wonder who made other, similar stands says nothing about whether potential customers would be confused about (or care) whether a red-and-green, heavy-duty Christmas tree stand in an open white box was made by one manufacturer rather than another. *See, e.g., Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902,

910 (9th Cir. 1995) (declarations from the plaintiff's employees and wholesalers are of little probative value as to an assessment of consumer perception); *Filipino Yellow Pages, Inc. v. Asian Journal Pub'ns, Inc.*, 198 F.3d 1143, 1152 (9th Cir. 1999) ("Evidence of secondary meaning from a partial [i.e. biased] source possesses very little probative value.").

The evidence from Home Depot employees included testimony from a manager who told DFG that Home Depot was selling two stands (suggesting differentiation, not confusion), and hearsay "testimony" from an unidentified salesperson who believed the stands might have been manufactured by the same company because they were listed under the same SKU (i.e., Stock Keeping Unit) number.[11] Even if the salesperson's statement was correctly recalled by the DFG witness who testified to it, the salesperson expressly attributed any confusion to the use of the same internal Home Depot SKU number for both stands — not to any secondary meaning associated with DFG's supposed trade dress. The third Home Depot employee simply said the two stands looked similar, not that he thought anybody would be confused into thinking they came from the same source. AP04794. In that regard, it should be noted that there are and were several Christmas tree stands on the

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[11] One of DFG's witnesses, Mrs. Boucher, testified about her conversation with the unidentified salesperson as follows: "A. It was out in the garden section, so I went out and asked the salesman which stand sold better. I was curious. Q. What did he say? A. He said he thought they sold about the same. And so then I asked him, I said where do you get them from; are they made by the same manufacturer, and he said I think the - MR. VEAL: Same objection. THE COURT: Overruled. THE WITNESS: And he said they have the same SKU number, so I believe they're made by the same company." AP04645 (Reporter's Transcript – Jury Trial Volume 4, May 9, 2003) (emphasis added).

market that "looked similar" to plaintiff's, but which did not and would not cause confusion. *See* App., *infra*, 2a.

Hence, as the Federal Circuit correctly held, DFG failed to produce sufficient evidence of actual confusion to support a finding that consumers viewed DFG's design and packaging as an indication that the product came from a particular source. DFG advances no reason for believing that any circuit would treat the "evidence" in this record as satisfactory evidence of actual customer confusion, or as relevant in any way to the secondary meaning analysis.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

November 7, 2005

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APPENDIX

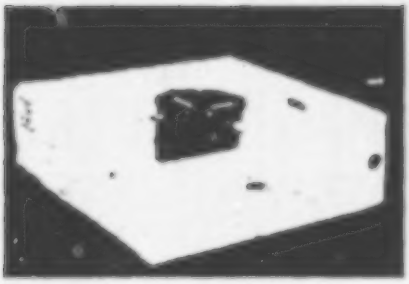
DFG'S STAND IN DISPLAY BOX

HOME DEPOT'S 2001 STAND IN DISPLAY BOX

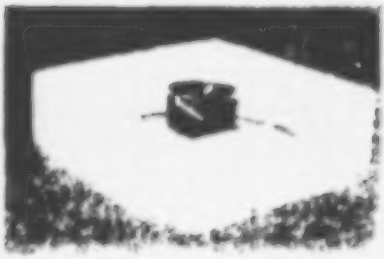
HOME DEPOT'S 2000 STAND IN DISPLAY BOX

ASSORTED HEAVY DUTY CHRISTMAS TREE STANDS

DFG



LEWIS LIFETIME TOOL



LAKEWOOD

HOME DEPOT

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No. 05-310

Supreme Court, U.S.
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In The Supreme Court of the United States

DECORATIONS FOR GENERATIONS, INC.,

Petitioner,

v.

HOME DEPOT USA, INC.,
INTERNATIONAL BUSINESS CORPORATION,
and MUTUAL ALLIED, LTD.,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

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INTRODUCTION

Respondents present the record in their briefs as though they were opposing a motion for summary judgment in the district court – indulging in often strained inferences and ignoring contrary evidence – in an effort to convince the Court not to repair the deep splits of authority under the Lanham Act shown in the Federal Circuit's reversal of the district court's judgment. By doing so, Respondents do an injustice to the service of the jurors and to the efforts of the district court judge who crafted a thorough and detailed decision demonstrating that the jury properly performed its duty of discerning the truth.

Respondents also go too far. If the evidence submitted at trial had been what Respondents have presented to this Court, no juror or district court judge in the country would have decided the case as they did – let alone a unanimous jury of nine and a district court judge as experienced as Judge Levi. Respondents' suggestions that some lack of common sense on the part of the jury and the judge or racial animus against Asian Americans explain the verdict are absurd and unworthy. *Cf.* Home Depot Brief at 6 ("HD Br."); MA/IBC Brief at 15 ("MA/IBC Br.").

Further, Respondents rewrote the record to make it appear that the Federal Circuit Court of Appeal reversed because it reconsidered the credibility of the witnesses and reweighed the evidence, and found it in every instance to be precisely as Respondents contended in their opening statement. The Federal Circuit did not – and could not – do this. The Federal Circuit's decision barely mentions the evidence, let alone analyzes it to the degree required to disregard jury findings on questions of fact. The Federal Circuit Panel reversed because it had a materially different understanding from that of the district court as to the meaning of the term "nonfunctional" as it is used in Lanham Act § 43(a)(3), and on other issues of law.

To the Panel, to some circuits, and to Respondents, aesthetic features are "functional" and incapable of protection under the Lanham Act if they have an "operational or utilitarian function" in *marketing* a product. *See* HD Br. at 7,

citing Aromatique, Inc. v. Gold Seal, Inc., 28 F.3d 863, 874 (8th Cir. 1994); MA/IBC Br. at 17. Others, including the Ninth Circuit and Professor McCarthy, reject this definition. *See Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1260 (9th Cir. 2001) "[T]rade dress cannot be both 'functional and purely aesthetic.' Such a formulation is internally inconsistent and at odds with the commonly accepted view that functionality denotes utility."); *see also J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition* (4th ed. 2004), § 7:81 ("Taken literally, [aesthetic functionality] negates protection for all trademarks.").

As Professor McCarthy and others have documented, there are clear differences among the circuit courts on whether aesthetic trade dress that is useful in marketing a product is "functional" under the Lanham Act, and thus whether competitors may freely copy it. *See, e.g.*, McCarthy at §§ 7:80, 15:38. Respondents MA/IBC interpret dicta from this Court's decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003), as resolving these circuit splits by establishing competitors' nearly absolute right to copy such trade dress so long it is not the subject of a patent or copyright, regardless of whether consumer confusion results. *See* MA/IBC Br. at 20-21. This rule would leave as potentially protectable trade dress only that which has no use in marketing, thereby severely curtailing the protection of trade dress afforded by the Lanham Act. Until this Court resolves the conflicts among the circuits and clarifies whether its discussion of competitors' right to copy in *Dastar* goes as far as MA/IBC contends, competitors and courts will continue to struggle with these issues, expending public and private resources. Further, overseas manufacturers will be emboldened to simulate the aesthetic product and packing features of established domestic manufacturers without regard for resulting consumer confusion.

Since Respondents' statements of the case amount largely to recantations of their closing argument at trial, DFG cannot address all of the new matter raised. DFG implores the Court to consider the record itself, or at least the evidence confirmed by the district court's decision. In

this brief, DFG will address only the most critical areas where Respondents have improperly presented the record as though *they* had prevailed at trial.

RESPONSE TO MISSTATEMENTS OF THE RECORD

A. DFG'S TRADE DRESS WAS THE "OVERALL APPEARANCE OF ITS STAND AND PACKAGING," AND IT NEITHER "DISCLAIMED" ANY ASPECT OF IT, NOR CLAIMED ANY OF ITS INDIVIDUAL FEATURES IN ISOLATION

Based on one sentence in closing argument, ripped from its context, Home Depot announces that DFG did not claim exclusive rights in the particular shade of green used for its stands. HD Br. at 4. Similarly, MA/IBC asserts that, based on a portion of its cross-examination of Jim Boucher, DFG "disclaimed" several features of its overall trade dress. MA/IBC Br. at 5. As the record and the district court's decision make plain, in both instances DFG only "disclaimed" any right to exclude competitors from using any *particular* feature of DFG's trade dress.

Throughout trial, DFG repeatedly made clear that competitors could and did use many of the individual features of DFG's trade dress to make and package competitive pipe stands. This evidence formed the centerpiece of DFG's proof that its particular trade dress was nonfunctional. DFG only claimed the right to exclude others from copying the overall visual impression of its stand alone or in combination with its packaging ("Composite Dress"). These were the only claims put to the jury. (AP05560-62) Respondents made no effort to amend the jury instructions to reflect any supposed "disclaimers." Further, the jury instructions repeatedly directed the jury to consider DFG's trade dress "as a whole," *not* its individual features. (AP05561-63)

DFG stressed these principles throughout its case. (*See, e.g.,* AP05226:3-18; 5228:3-32:24; 5237:2-39:11; 5274:1-76:5;

5326:18-27:19) In opening statement, DFG showed the jury several competing stands to demonstrate that DFG was

> not contending that it's the only company that can make a green stand [but only] that somebody who wants to compete fairly has a world of shades, has a world of styles, has a world of packaging designs, and certainly has an unlimited number of trade names they can choose if what they want to do is associate their product with their company.

(AP04041:15-21) DFG emphasized in closing argument that its case was

> not about little bits and pieces. We're not saying other people can't use holly berry. We're not saying other people can't have a box that's white. But you add up all of those things, and you got the overall look. . . .

(AP05229:1-8; *see also* AP04026:9-17; 4039:1-41:22; 4163:25-71:5; 5439:23-40:4; 5228:3-32:24; 5251:8-52:6; 5275:18-76:5; 5327:3-19)

The district court denied JMOL based on DFG's Composite Dress, which the court consistently confirmed included DFG's "exact shade of red and green," as well as packaging features which MA/IBC now contends were "disclaimed," stating:

> While many elements of the stand and packaging are functional, the jury could have found that the *overall combination of these elements* is not utilitarian or that certain features have a functional and nonfunctional aspect. For example, the *exact shade of red and green used for the stand*, the plastic rim in a contrasting red or green color, and the packaging of the product in a white open-top box decorated with *red and green Christmas motifs* do not give DFG a utilitarian advantage, particularly when *considered in combination*. Defendants easily could have made their tree stands in different shades of red and green; they could have eliminated the contrasting plastic rim or at least designed it to be different in width

> or color than plaintiff's; and they could have made the box another color that would stand out from other products in the way plaintiff's white box does. . . . Defendants could have made the overall look of their product and packaging distinctive from the [DFG] stand without sacrificing any utilitarian advantage.

(App. 16a [emphasis added].) Later in its decision, the district court again referenced the supposedly "disclaimed" aspects of DFG's Composite Dress:

> [T]he method of manufacture does not appear to have dictated several elements of the trade dress, like the width of the contrasting plastic red band, the length of the legs, the height of the holder, and the *exact shades of colors used*. It also did not dictate the use of a white box with *red and green trim* or other aspects of the defendants' packaging, including the absence of a brand name.

(*Id.* at 18a [emphasis added].)

DFG stressed, and the district court's decision recognized, that use of the pipe stand design and the colors red and green could be and were used by DFG's competitors whose Composite Dresses created a "different overall look." (App. 17a, 22a, and 26a.) That does not mean that DFG "disclaimed" any aspects of its Composite Dress.[1] Instead, it was powerful evidence that DFG's trade dress was not functional because there were unlimited alternative trade

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[1] Tellingly, Home Depot did not contend that DFG's particular shade of green was not part of its trade dress until oral argument before the Court of Appeal, when DFG would not have the opportunity to place the statement in context. Likewise, MA/IBC, whose counsel on appeal tried the case, has never made such an outlandish assertion, but instead argues at length that because the particular shade of green used by DFG was one of an almost infinite variety of shades of "Christmas green," that it could not possibly contribute to a protectable trade dress. *See* MA/IBC Br. at 6-7. If this were so, then no trade dress for a lawn product or an "environmentally sensitive" product could possibly be protectable under the Lanham Act either since the use of some shade of green is generally an aspect of such products and their packaging.

dress designs available to competitors who wanted to make functionally equivalent pipe stands.[3] If DFG's trade dress is non-functional, Respondents' intentional copying is, in fact, probative of secondary meaning even by Respondents' view of the law.

Although Respondents made no objection at trial (AP04998:15-22), MA/IBC now complains that the description of DFG's trade dress in the jury instructions was not sufficiently detailed. MA/IBC's contention, however, only highlights the practical problems created by the law's uncertainty in this area. As Judge Levi's comments during the instructions conference show, the parties were speaking different languages when it came to the definition of trade dress, making it impossible to formulate a description in the instructions:

> It's the dispute, essentially, the two of you have been having for the entire case, and it's just one the law apparently hasn't thoroughly resolved yet.

(AP05000:22-24) Lawyers and courts cannot resolve disputes and competitors cannot order their conduct if the concepts governing them are conflicting and confused. Whichever way these issues come to be resolved, the Court should grant *certiorari* to resolve them.

B. THE EVIDENCE OVERWHELMINGLY SUPPORTED THE JURY'S CONCLUSION THAT THE CONTRASTING PLASTIC RING WAS NON-FUNCTIONAL

Home Depot betrays its overall approach to presenting the record to this Court by attempting to support the

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[3] MA/IBC is incorrect in saying the availability of competitive pipe stands is relevant only to likelihood of confusion. MA/IBC Br. at 9. The district court's focus on whether protecting DFG's Composite Dress would burden competition applied the analysis required by both the Ninth and Federal Circuits. *Clicks*, 251 F.3d at 1260; *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1277 (Fed. Cir. 2002) (Dyk, J.) (The "effect upon competition is really the crux of the functionality inquiry.").

Federal Circuit's reversal on the ground that "there was evidence that" the contrasting ring was functional, as though the existence of substantial evidence was sufficient to support reversal on an issue of fact. HD Br. at 3. While it may be that Respondents submitted sufficient evidence to withstand a motion for summary adjudication on this issue, the evidence supporting the jury's and district court's contrary conclusion was overwhelming. The sole evidence submitted to show the functionality of the contrasting ring was testimony by a Home Depot vendor named Daniel Wright, President of Lewis Tools, who admittedly designed his stand with DFG's product in mind. (AP05029)

Putting aside the unquestionable fact that the ring's width and contrasting color serve no utilitarian function at all, for the Federal Circuit to have concluded from Mr. Wright's testimony that the plastic ring served a utilitarian function on *DFG's* stand it would have to have found (1) that Mr. Wright was telling the truth despite his obvious bias and motivation to conceal his true intention for adding the ring,[3] and (2) that because the plastic ring was desirable to avoid burs on *Lewis Tools'* stand, that that was necessarily the reason DFG added a plastic ring on its much thicker pipe. (*See* Exh. 166; *see also* AP04170 [discussing Lewis Tools' lighter design and construction].) Further, the Court of Appeals would have to have disregarded the unrebutted evidence that the Bowling, Lakewood, and Kelko pipe stands were all made *without* plastic rings (*see* AP06302-03; Exhs. 169-70), and also decided that Jim Boucher and Rhonda Boucher lied under oath when they testified that the purpose of the contrasting ring on DFG's stand was to help make it "stand out," and to give it a "more finished

[3] MA/IBC asserts that DFG never argued at trial that Lewis Tools copied DFG's trade dress because it recognized the goodwill associated with it. MA/IBC Br. at 9. In fact, DFG's counsel argued in closing: "And you heard Mr. Wright from Lewis Tools testify that . . . when they made that box, they were aware of the [DFG] product. And you can make your own conclusions from that." (AP05250:19-22)

appearance." (AP04148-51; 4297-300; 5196) Finally, the Federal Circuit would have to have ignored or disbelieved Jim Boucher's testimony that DFG already dealt with any burrs by the far simpler and cheaper expedient of putting the pipe on a grinder, as the other pipe stand manufacturers apparently do. (AP04118)

Nothing in the Federal Circuit's decision suggests that it decided without seeing them that DFG's witnesses were perjurers, or that it re-balanced the evidence to reach the far-fetched result posited as "fact" by Respondents. The Federal Circuit's decision is plainly grounded on an understanding of functionality that renders trade dress that is attractive to consumers, such as DFG's contrasting decorative ring, unprotectable.

C. THE EVIDENCE OVERWHELMINGLY SUPPORTED THE JURY'S SPECIFIC FINDING THAT RESPONDENTS "INTENTIONALLY USED [DFG'S] TRADE DRESS FOR THE PURPOSE OF DECEPTION OR CAUSING CONSUMER CONFUSION"

Despite the jury's specific finding that Respondents "intentionally used [DFG's] trade dress for the purpose of deception or causing consumer confusion" (AP00045), MA/IBC claims that it was "undisputed that Respondents intentionally made changes to their products to avoid any rights they believed Petitioner had. . . ." MA/IBC Br. at 22. In fact, one of the most striking aspects of this case was Respondents' complete failure to explain their conduct. No one offered any testimony about what "rights" they believed DFG had, or why they deliberately copied DFG's product and packaging, or why they sold their copied product without a brand, side-by-side with DFG's, for the same price, under the same price card. To the contrary, the Home Depot witness responsible for the decision to copy DFG's product and packaging repeatedly and disingenuously

claimed to have "no recollection" whatsoever of anything at all about this case. (*See* AP04554-60) Under the circumstances, as the district court confirmed,

> The jury could have inferred that there was no reason for defendants to make their product and packaging so similar to plaintiff's, without a prominent brand name, other than an intent to capitalize on [DFG's] secondary meaning.

(App. 23a.)

The evidence established that Home Depot's import merchant knew the pattern of sales DFG had established in particular regions and deliberately had DFG's trade dress copied to capitalize on DFG's goodwill. Under the law of the Ninth Circuit, this intentional copying is probative of secondary meaning whether what was copied was functional or not:

> We do not accept that there is a dichotomy between "functional" and "source identifying." Although the evidence relevant to them may overlap, *these are two separate aspects of the protectability analysis. Whether a feature is functional has no direct bearing on whether it plays a source-identifying role. The functionality analysis should not be conflated with the inquiry into whether "the purchasing public associates the dress with a particular source."*

Clicks, 251 F.3d at 1260 (emphasis added). Such intentional copying could itself support the jury's verdict, and should certainly suffice coupled with evidence of DFG's continuous and exclusive use of its trade dress – which the Federal Circuit confirmed.[4]

The facts here squarely present the issue of the evidentiary significance of intentional copying for the purpose of confusing consumers, and the relation of that

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[4] To the extent Congress has spoken on the quantum of proof sufficient to support secondary meaning, it did so in 15 U.S.C. § 1052(f), where it established that five years of exclusive and continuous use was *prima facia* evidence of secondary meaning for registration.